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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,511	12/06/2001	Kim Marie Hoertsch	13,724	6460

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EXAMINER

CHIN, RANDALL E

ART UNIT	PAPER NUMBER
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1744

DATE MAILED: 04/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary	Application No. 10/010,511	Applicant(s) HOERTSCH, KIM MARIE	
	Examiner Randall Chin	Art Unit 1744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
4a) Of the above claim(s) 4,6-9,11,12,15 and 17-22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 is/are allowed.
- 6) ☒ Claim(s) 1,2,5,10 and 13 is/are rejected.
- 7) ☒ Claim(s) 3 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03212002</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

1. Claims 4, 6-9, 11, 12, 15 and 17-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the Paper filed March 1, 2004.

2. Applicant's election of Group I, species of Figs. 1-3, claims 1, 2, 3, 5, 10, 14 and 16 in the Paper filed March 1, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

It should be noted that claim 13 has also been included for examination since elected claim 14 depends on claim 13. Claim 13 recites that the swab comprises a nonwoven fabric which is disclosed in elected Figs. 1-3.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 5, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitri '559.

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With respect to claim 1, Mitri '559 teaches a disposable device comprising an elongated member 11 having a first end and a second end, and a non-woven swab fabric 17 secured to the first end (see Figs. 1-6). Mitri '559 recites in col. 3, lines 1-13 that the swab material can be cotton fiber that is a length of rope twisted material. The fact that it may be fibrous material does not necessarily mean that it is "woven." Cotton can be woven or non-woven and one skilled in the art would find it obvious to use cotton in non-woven form depending on application at hand or economical considerations.

As for claim 2, Fig. 4 shows the nonwoven fabric having a base plane 25 with multiple "raised areas" 17, the multiple raised areas protruding from the base plane to impart a three-dimensional topography.

As for claims 5 and 10, Mitri '559 teaches all of the above recited material in addition to a plastic hollow (col. 3, line 1) elongated member 11 which is deemed to be thermoplastic under conventional manufacturing techniques (col. 2, lines 65-67). With respect to the elongated member having a specific compressive energy in terms of Joules, it is the Examiner's position that to have made Mitri's elongated member compressible (even though it is compressible already to a degree due to its plastic nature) would be obvious in order to better manipulate the device during a cleaning procedure.

As for the device being an oral hygiene device as recited in claims 1 and 5, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of

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performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 5 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Weldon '440.

With respect to claim 1, Weldon '440 teaches a disposable oral (col. 2, lines 3-5) hygiene device comprising an elongated member 5 having a first end and a second end, and a non-woven swab fabric (col. 2, lines 45-50) at 2 secured to the first end.

As for claim 2, the Figure shows the nonwoven fabric having a base plane (in plan view) with multiple "raised areas," the multiple raised areas protruding from the base plane to impart a three-dimensional topography.

With respect to claim 5 reciting that the elongated member has a specific compressive energy in terms of Joules, it is the Examiner's position that to have made

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Weldon's elongated member compressible (even though it is compressible already to a degree due to it's plastic nature as recited in col. 2, lines 34-35) would be obvious in order to better manipulate the device during a cleaning procedure. Claims 5 and 13 teach all of the recited subject matter as set forth for claim 1 above.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Ljungberg '041.

With respect to claim 1, Ljungberg '041 teaches a disposable oral hygiene device comprising an elongated member 1 having a first end and a second end, and a non-woven swab fabric (col. 1, lines 48-55) 2, 3 secured to the first end. Note here, Ljungberg '041 points out that the bristles can be formed of a "nonwoven warp" piece of woven fabric and is still deemed to meet claim 1.

8. Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ljungberg '041.

With respect to claim 5 reciting that the elongated member has a specific compressive energy in terms of Joules, it is the Examiner's position that to have made Ljungberg's elongated member compressible (even though it is compressible already to a degree due to it's plastic nature as recited in col. 1, lines 40-42) would be obvious in order to better manipulate the device during a cleaning procedure. Claims 5 and 13 teach all of the recited subject matter as set forth for claim 1 above.

Allowable Subject Matter

9. Claim 16 is allowed.

Claims 3 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Reber, Bloch, and Truhan are pertinent to various other swab configurations.

11. Any inquiry concerning this communication or earlier communication from the Examiner should be directed to Randall Chin whose telephone number is (571) 272-1270. The Examiner can normally be reached on Monday through Thursday and every other Friday.

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Robert Warden, can be reached at (571) 272-1281. The number for Technology Center 1700 is (571) 272-1700.

The central fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

R. Chin

A handwritten signature in black ink, appearing to read "Randall Chin", with a long horizontal flourish extending to the right.

Randall Chin
Primary Examiner
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